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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,289	09/06/2000	Nouri E. Hakim	4009.016	9451

7590 03/07/2003
Morris E. Cohen, Esq.
Suite 217
1122 Coney Island Avenue
Brooklyn, NY 11230

EXAMINER

MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,289

Applicant(s)

HAKIM, NOURI E.

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 17-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 51-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

The Request for Continued Examination, paper No. 11, filed 11/19/02 has been approved.
The Notice of Improper Request for continued Examination (RCE), paper No. 14, has been withdrawn.

Election/Restrictions

1. Claims 17-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected invention as set forth Office Action No. 8.

Priority

2. Applicant's claim for priority of applications French Design Patent No. 976, 785, U.S. Design Patent ~~29/119,049~~ and US Design Patent ~~29/088,360~~ is acknowledged. However, the applications upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-15, 51 and 52 of this application. *Inter alia*, these applications fail to disclose a hole at the top of the nipple cover and the cover member.

Claim Rejections - 35 USC § 102

3. Claims 1-16, and 53 are rejected under 35 U.S.C. 102(a) as being anticipated by Shefflin (5,878,898). Shefflin teaches a cover for a nipple having a sealing element 72.

Regarding claim 6, Shefflin teaches a flange in the embodiments of Figs. 2A, and 13.

Regarding claim 10, in the very least, the cap in fig. 16 has a different color than the cover (note the cartoon figure).

Regarding claim 4, note the dome-like bottom surface in Fig. 13.

Regarding claim 6, portion 45 is the flange as set forth.

Regarding claim 14, note the upper surface is flush with portion 18 in Fig. 17.

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Regarding claim 15, note the compressed nipple as shown in Figs. 10, 12 and 13.

It is noted that Shefflin has priority filing dated Oct 14, 1992.

4. Claims 1-16, and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Held (5150801). Held teaches a cover for a nipple having a sealing element as shown in Figs. 12 and 13.

5. Claims 1-4, 5-9, 11-13, 15, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Bannister et al. (2986296). Bannister teaches a cover and sealing elements 25, 71 in the embodiment of figures 1-12.

Claim Rejections - 35 USC § 103

6. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Signorini in view of Shefflin. Signorini teaches a baby body, a nipple and a cover, a cap with recesses to accommodate the threads of the handle as shown in Fig. 5A -7. Signorini meets all claimed limitations except for the top with an orifice on the top. Shefflin teaches that it is known in the art to provide a top with an orifice on the top. It would have been obvious to one of ordinary skill in the art to provide a top with an orifice on the top in Signorini as taught by Shefflin to prevent leaking and/or to access the nipple easily.

With respect to the recess for receiving a portion of the handle in a mating relationship, please note that the cap 12 in Signorini mates with handle 24 as shown in Fig. 6. The term "recess" is broad, the inside surface, where the threads 14 is formed, is considered the recess.

Furthermore, the recesses between the protrusions of the threads 14 are also considered as recesses.

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With respect to the limitation that the cap screws onto the baby bottle, the cap 12 is indirectly screwed onto the baby bottle. Claim 51 does not require the cap to be directly screwed onto the baby bottle.

7. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yagi in view of either Shefflin or Held (5150801), and further in view of Signorini. Yagi meets all claimed limitations except for the sealing element on the top. Either Shefflin or Held teaches that it is known in the art to provide a sealing element on a top of a baby bottle. It would have been obvious to one of ordinary skill in the art to provide a top having a sealing element in Yagi as taught by either Shefflin or Held to provide added protection.

With respect to the handle, Signorini teaches that it is known in the art to provide a handle, it would have been obvious to one of ordinary skill in the art to provide a handle in Yagi as taught by Signorini to handle the bottle easily.

With respect to the recess for receiving a portion of the handle in a mating relationship, please note that the cap 12 in Signorini mates with handle 24 as shown in Fig. 6. The term "recess" is broad, the inside surface, where the threads 14 is formed, is considered the recess. Furthermore, the recesses between the protrusions of the threads 14 are also considered as recess.

With respect to the limitation that the cap screws onto the baby bottle, the cap 12 is indirectly screwed onto the baby bottle. Claim 51 does not require the cap to be directly screwed onto the baby bottle.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but they are not persuasive. With respect to the Held reference, applicant argues that Figs. 11-13 do not teach a

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seal, the term "seal" is broad, when the cover 54 is engaged with the hole 52 the cover form a seal as claimed, i.e., it closes the opening. It is unclear exactly what is the difference between the seal as claimed and the seal as set forth in Held.

With respect to the 102(a) rejection, applicant argues that Shefflin reference was not made available to the public, and therefore, cannot be considered as printed publication. Please note the following quotation from the MPEP.

901.02 Abandoned Applications

If an abandoned application was previously published under 35 U.S.C. 122(b), that patent application publication is available as prior art under 35 U.S.C. 102(a) and 102(b) as of its patent application publication date because the patent application publication is considered to be a "printed" publication within the meaning of 35 U.S.C. 102(a) and 102(b), even though the patent application publication is disseminated by the U.S. Patent and Trademark Office (Office) using only electronic media. See MPEP § 2128.

Additionally, as described in MPEP § 901.03, a patent application publication published under 35 U.S.C. 122(b) is available as prior art under 35 U.S.C. 102(e) as of the earliest effective U.S. filing date of the published application against U.S. applications filed on or after November 29, 2000 and applications filed prior to November 29, 2000 which are voluntarily published. As provided in 37 CFR 1.11(a), unless a redacted copy of the application was used for the patent application publication, the specification, drawings, and all papers relating to the file of an abandoned published application are open to inspection by the public, and copies may be obtained from the Office. The information that is available to the public under 37 CFR 1.11(a) may be used as prior art under 35 U.S.C. 102(a) or 102(b) as of the date the information became publicly available.

Where an abandoned application is referred to in an issued U.S. patent or in one of the types of published or publicly available patent applications described in 37 CFR 1.14(e), access to the abandoned application file may be provided to the public. See 37 CFR 1.14(e)(2). Similarly, a copy of the application-as-filed and/or a copy of the file wrapper and its contents may be publicly available. See 37 CFR 1.14(c). Subject matter from abandoned applications which is available to the public under 37 CFR 1.14(c) or 37 CFR 1.14(e) may be used as prior art against a pending U.S. application under 35 U.S.C. 102(a) or 102(b) as of the date the subject matter became publicly available.

In re Heritage, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a previously copending but subsequently abandoned application, such disclosure is available as a reference. See also In re Lund, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).

It has also been held that where the reference patent refers to a previously copending but subsequently abandoned application which discloses subject matter in common with the patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. In re Switzer, 166 F.2d 827, 77 USPQ 156 (CCPA 1948); Ex parte Peterson, 63 USPQ 99 (Bd. App. 1944); and Ex parte Clifford, 49 USPQ 152 (Bd. App. 1940). See MPEP § 2127(a).

Published abstracts, abbreviations, defensive publications (MPEP § 901.06(d)), and statutory invention registrations (MPEP Chapter 1100) are references.

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The rejection under 102(a) is proper and maintained.

With respect to the rejections over Signorini regarding the limitation that the cap screws onto the baby bottle, the cap 12 is indirectly screwed onto the baby bottle via the handle. Claims 51 and 52 do not require the cap to be directly screwed onto the baby bottle.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai
Examiner
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February 28, 2003